

## **REMARKS**

This paper is responsive to the Office Action dated April 28, 2010. All rejections are respectfully traversed and reconsideration is respectfully requested. Several claims have been amended to assure clarity.

### **Interview Request**

The undersigned yet again respectfully requests the courtesy of a telephone interview with the Examiner at the Examiner's earliest convenience in order to expedite prosecution and avoid the necessity of appeal. The undersigned has previously left multiple telephone messages for the Examiner, has requested multiple interviews from the Examiner both in telephone messages and in writing. The telephone calls have not been returned and the written requests have been ignored. The undersigned wishes to resolve any matters that might remain after submission of the present response and supporting evidence and can be reached at the telephone number below.

### **Response to Rejections Under 35 U.S.C. §101**

Claims 1-43 have been rejected as non-statutory based on the Examiner's reasoning that "the claims refer to a method that would not require any particular machine or apparatus to be performed and therefore are not considered to be in one of the statutory categories." Applicant notes that the present Office Action was mailed prior to the *Bilski v. Kappos* SCOTUS opinion No. 08-964 decided June 28, 2010. Applicant respectfully traverses on the basis of the following:

#### **The assertion that the method does not require a machine is technical error.**

Applicant notes that all claims do in fact require a machine or apparatus as follows:  
Claims 1-3: call for a content delivery system which clearly falls within the meaning of a machine.  
Claim 3: calls for a cable television system headend.  
Claims 4-8: call for first and second encryption systems and a PID filter.

Claim 5: calls for a demultiplexer output path.

Claim 6: calls for a decrypter.

Claim 7: calls for a set top box.

Claims 8-16: call for a first buffer and a second buffer and switching the stream of packets.

Claim 16: calls for an electronic storage medium and has been amended per the Director's memo of January 26, 2010 in order to expedite prosecution.

Claims 17-25: call for first and second encryption systems, first and second buffers, as well as detecting, switching and searching operations which clearly cannot in any reasonable implementation be done without a machine.

Claim 25: calls for an electronic storage medium and has been amended per the Director's memo of January 26, 2010 in order to expedite prosecution.

Claims 26-34: calls for first and second buffers, and detecting switching and searching operations as described above.

Claim 34: calls for an electronic storage medium and has been amended per the Director's memo of January 26, 2010 in order to expedite prosecution.

Claims 35-43: calls for first and second buffers, etc.

Claim 37: calls for a DMA register.

Claim 43: calls for an electronic storage medium and has been amended per the Director's memo of January 26, 2010 in order to expedite prosecution.

Applicant further notes that many of the claims further pass the transformation test. Accordingly, the Office's assertion with regard to the absence of "any particular machine or apparatus is in clear error. This error has resulted in legal error and the rejection should be removed.

It is noted, in connection with the above that in *Bilski* the Machine-or-Transformation (M-or-T) Test was struck down as the only test for determining patentable subject matter, but in fact was only a useful indicator. With the new *Bilski* decision, it has been established that the M-or-T Test is insufficient to establish a lack of subject matter eligibility under 35 U.S.C. § 101 alone. Hence, even assuming *arguendo* that the test was not met by the above claims, this alone

is not sufficient to support the current rejection. Hence, reconsideration and allowance are respectfully requested.

The present claims do not attempt to preclude abstract ideas, laws of nature or natural phenomena.

The *Bilski* decision, clarified that abstract ideas, laws of nature and natural phenomena are currently the only explicitly excluded subject matter under 35 U.S.C. § 101. Taking several claims as illustrative examples, it is noted that:

- Claim 1 calls for “broadcasting” tables over a “content delivery system”. Broadcasting over a content delivery system can in no way fall into any of the categories of an abstract idea, law of nature nor natural phenomenon.
- Claim 4 calls for determining associations from a table and setting a PID filter to permit passage of packets. Setting parameters of a PID filter is also neither an abstract idea, law of nature nor natural phenomenon.
- Claim 8 calls for storing packets in first and second buffers. Doing so is also neither an abstract idea, law of nature nor natural phenomenon.

By these illustrative examples that can be readily extended to all of the rejected claims, it is clear that the rejected claims do not fall within any of the only subject matter explicitly excluded by the Supreme Court from patentability. Hence, reconsideration and allowance are respectfully requested.

The Office has failed to make a *prima facie* case adequate to pass the burden to Applicant.

The Office Action rejected claims 1-43 under 35 U.S.C. § 101 as allegedly not reciting patentable subject matter. More specifically, the Office appears to hold that the claims allegedly do not meet the Machine-or-Transformation (M-or-T) Test, (based on the language of section 2 of the Office Action). Applicant respectfully submits that application of the M-or-T Test is insufficient to make a *prima facie* rejection under 35 U.S.C. § 101 and further, Applicants’ claims are compliant with 35 U.S.C. § 101 because the claims are not directed to abstract ideas,

laws of nature or natural phenomena as explained above. Moreover, as noted above, the claims in fact pass the M-or-T test which is deemed to be an important and useful clue indicative of patentable subject matter (which Applicant's claims pass).

Applicants respectfully note that even properly demonstrating a lack of compliance with the M-or-T Test (which the Office has failed to do in this case) is insufficient to make a *prima facie* rejection under 35 U.S.C. § 101. Where no *prima facie* case has been made, the burden cannot be passed to Applicants. In its memo to Examiners regarding *Bilski*, the USPTO correctly noted that the Supreme Court stated that the M-or-T test is a "useful and important clue" for determining whether claims recite patentable subject matter (see *Bilski*, Slip Op. at 8). This test, as noted above is clearly passed by the current claims. However, this merely means that claims meeting the M-or-T test are likely to recite patentable subject matter. It is not dispositive that claims that allegedly fail the M-or-T test do not recite patentable subject matter. As stated by the Supreme Court, "[a]dopting the machine-or-transformation test as the sole test for what constitutes a 'process' (as opposed to just an important and useful clue) violates ... statutory interpretation principles" (Slip Op. at 6-7). Rather, the only way the USPTO can currently meet its burden for rejecting claims under 35 U.S.C. § 101 is to demonstrate that the claims are directed to an abstract idea, a law of nature or natural phenomena. These are the only classes of subject matter explicitly forbidden by the Supreme Court as not being patent-eligible. The Supreme Court explicitly overruled the M-or-T test as the sole test for determining patentable subject matter, so the application of the M-or-T test to allegedly pass the burden to Applicants to demonstrate patentable subject matter is insufficient.

The undersigned notes that the USPTO has instructed Examiners to continue to reject claims under 35 U.S.C. § 101 when the M-or-T test is allegedly not met. The USPTO believes that this passes the burden to Applicants to demonstrate that the claims recite patentable subject matter. However, under the current law, merely demonstrating that claims do not meet the M-or-T test does not show that the claims are directed to an excluded class of subject matter. Instead, it would be necessary for the USPTO to demonstrate that the claims are either directed to abstract ideas, laws of nature or natural phenomena. Without such a demonstration, the USPTO cannot make a *prima facie* case. Moreover, the USPTO instructions to Examiners are clearly

contrary to the established law of *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992) (see MPEP 2106(IV)(D)) which held that “the examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability.” (emphasis added)

The Claims Recite Patent-Eligible Subject Matter because they are not Directed to an Excluded Class.

In the interest of furthering prosecution, Applicants respectfully submit that the claims are patent-eligible because they are not directed to abstract ideas, laws of nature or physical phenomena. For instance, the claimed subject matter is physical rather than being a mere mental process, and thus is not an abstract idea. Unlike the claims at issue in *Bilski*, where the risk hedging method could be largely performed mentally by a human being, the claimed invention has physical features and actions that preclude them from being in one of the prohibited subject matter of abstract ideas, laws of nature or physical phenomena. Accordingly, it is respectfully submitted that the rejection is improper, a *prima facie* case of non-statutory subject matter has not been established, the claims meet the M-or-T test and the claims are statutory.

In view of all of the above, reconsideration and allowance are proper and are respectfully requested.

**Response to Rejections Under 35 U.S.C. §103(a)**

All claims were rejected based upon the Blatter reference alone. This reference has been the primary reference used in examination of this application for most of its prosecution.

Regarding Independent claim 1:

The Office has repeatedly and correctly admitted (most recently for example on pages 4 and 6 of the current Action) that “Blatter discloses encrypting broadcast programs two or more times, but does not clearly disclose that the same portion of the program or duplicate of the program is encrypted under a second encryption system.” The Office then asserts that “Blatter clearly discloses a system which encrypting [sic] broadcast programs two or more times. We

need not delve into the correctness of this latter statement in this response, but note that the Office proceeds to provide reasoning for the obviousness of the claims by stating:

“Hence, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the system of Blatter to further encrypt the same portion or duplicates of the program to provide additional security to the broadcast content.” (emphasis added)

This assertion is false and based upon technical error which has been previously proven to be technical error by expert testimony that has been ignored.

Applicant wishes to note that in all claims at issue, first and second duplicate copies of a portion of the program are each encrypted by first and second encryption systems (to paraphrase without intent of imposing additional limitations). This results in broadcast or receipt of two copies of the same content with each being encrypted under two different encryption systems.

The Office asserts that this would be obvious in order “to provide additional security to the broadcast content.” This issue has already been addressed by an expert. The Examiner’s attention is directed to the declaration of Dr. Charles Baugh submitted previously (which has apparently been correctly accepted as fact by virtue of the removal of all prior rejections and failure to provide any contradictory evidence). Dr. Baugh presents expert evidence in his declaration at the bottom of the second page thereof which states:

- “• I have been asked by Mr. Miller to provide a response to question #1: Is content where one duplicated portion is encrypted under a first encryption system and another duplicated portion is encrypted under a second encryption system, more cryptographically secure than an arrangement wherein a single one of the encrypted copies (one of the duplicates) is supplied?
- The answer to question #1 is no. At best, the content is no more secure, but content supplied in multiple duplicate copies where each duplicate copy is individually encrypted with a different encryption system may in fact be less secure in many scenarios. I know of no way that one could enhance the cryptographic security of content by supplying multiple copies of the content with each copy individually encrypted with a different encryption system. This is true because the set of encrypted

copies can be no more secure than the copy encrypted by the weakest of the encryption systems.” (emphasis added)

Hence, the Office’s assertion of motivation for purposes of providing additional security is based on technical error. In view of the above evidence, for which the Office has apparently accepted as fact and presented no contrary evidence, it is clear that the Office’s reasoning for making the proposed modification to Blatter to meet claim 1 is technically erroneous, and in fact would lead one of ordinary skill in the art away from the presently claimed method since it may produce less secure broadcast content. Accordingly, the Office has failed to meet its burden of establishing *prima facie* obviousness by failure to provide a technically accurate reasoning for making the proposed modification. (Note that this error was pointed out to the Examiner in the prior Office Action and evidently has not received due consideration since the Examiner persists in making this technical error without providing any evidence to contradict Applicant’s expert witness.) It is submitted that it is clear error to provide a technically flawed reason for a motivation to make the proposed modification. Accordingly, reconsideration and allowance of claim 1 are respectfully requested.

Regarding dependent claims 2-3:

These claims depend from claim 1 and are allowable for at least the reasons presented above. Reconsideration and allowance are respectfully requested.

Regarding all other independent claims 4, 8, 17, 26, 35 and 44:

The Office rejects claim 4 using the same reasoning for modification of Blatter to meet the claim features at the paragraph spanning pages 7 and 8. The Office also rejects claim 8 using the same reasoning at the bottom of page 9. All other independent claims are being rejected for the same reasoning as claim 8. Accordingly, the Office fails to establish *prima facie* obviousness of all independent claims 4, 8, 17, 26, 35 and 44 as well using the same flawed reasoning as noted above for claim 1. Reconsideration and allowance of claim 4 are respectfully requested.

Regarding all other dependent claims 5-7, 9-16, 18-25, 27-34, 36-43 and 45-51:

These claims depend from their respective independent claims and are allowable for at least the reasons presented above. Reconsideration and allowance are respectfully requested.

### **Concluding Remarks**

Applicant believes that the above distinctions between Applicant's claims and the asserted motivation to make the Blatter modification make it unnecessary to provide further arguments at this point. As such, failure to address each and every argument made by the Patent Office is believed unnecessary at this point. Accordingly, failure to address each and every point made by the Patent Office is not to be considered acquiescence to any such point.

In view of the discussion above, claims 1-51 are in proper condition for allowance. Reconsideration is respectfully requested and notice of allowance for all pending claims is respectfully requested at the earliest possible date.

If any issues remain, the Examiner is again earnestly requested to contact the undersigned to expedite allowance and issue and avoid the necessity and expense of appeal. The undersigned is confident that any remaining issues can be quickly dispensed with by a telephone discussion of the issues, and thereby reduce expense to the Applicant and expedite resolution of the present application.



It is respectfully submitted that it is time to conclude the prosecution of this application and Applicant would be happy to work with the Examiner to address any remaining issues and avoid necessity and expense of appeal.

Respectfully submitted,

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